

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Ronald P. Doyle

July 25, 2006

Serial Nbr: 09/537,068

Filed: March 28, 2000

For: Using Biometrics on Pervasive Devices for Mobile Identification

Art Unit: 2134

Examiner: Norman M. Wright

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
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Sir:

This Reply Brief is submitted in furtherance of the Appeal Brief that was filed in this case on February 15, 2006.

DISCUSSION

1. Appellant respectfully submits the following comments on the Examiner's Answer dated May 26, 2006 (hereinafter, "the Examiner's Answer").

2. Appellant notes, in Section 10 of the Examiner's Answer, apparent confusion regarding several aspects of Appellant's claimed invention and Appellant's description thereof in Appellant's Appeal Brief dated February 15, 2006 (hereinafter, "Appellant's Appeal Brief"). Appellant apologizes if the previous explanations in Appellant's Appeal Brief were unclear, and with the descriptions herein, will address misinterpretations that have become evident in the Examiner's Answer.

3(a). In the Examiner's Answer, the Examiner repeatedly refers to simultaneously capturing biometric input from a first and second party (see, generally, Examiner's Answer, Pages 6 - 14), as well as "gathering or causing a first party's biometric [data] to be captured" (Examiner's Answer, Page 6, lines 17 - 18). The Examiner states that Appellant's specification does not teach this simultaneous capturing of biometric input. Appellant agrees. Appellant's claimed invention does not simultaneously capture biometric data from the first and second party, and Appellant's Appeal Brief does not state that this is specified in Appellant's claim language.

3(b). Rather, what Appellant specifies in his independent Claims 1, 10, and 19 -- and what Appellant has stated in Appellant's Appeal Brief -- is that there are two distinct parties involved. The first party is one who [physically] possesses the mobile pervasive device (Claim 1, line 5),

while the second party is the one whose biometric data is being captured (Claim 1, lines 4 - 6 and lines 7 - 8). Notably, it is implicit in these claims that the biometric data of the second party is captured *while* the mobile pervasive device is [physically] possessed by the first party. Thus, it can be seen that there are 2 people present: one who is [physically] possessing the device, and another whose biometric data is being captured. It is this scenario that is being discussed in Appellant's Appeal Brief using the term "simultaneously involved". See, e.g., paragraph 19 of Appellant's Appeal Brief, and in particular, this term "simultaneously involved" is used at line 8 of paragraph 19 to describe this situation. Perhaps the sentence therein would be clearer by stating "when capturing biometric data of the second party", rather than "when capturing biometric data". (Appellant notes that it is already explicit in the claim language that this captured biometric data is that of the second party; refer to Claim 1, lines 4 - 6, "... for capturing ... biometric data of a second party", emphasis added, and lines 7 - 8, "... for identifying said second party using said captured biometric data ...".)

3(c). Similarly, paragraph 21 of Appellant's Appeal Brief refers to "two distinct parties who are simultaneously participating", and in this paragraph 21, Appellant is again referring to a first party who possesses the mobile pervasive device (Claim 1, line 5) and a second party whose biometric data is being captured (Claim 1, lines 4 - 6, "... for capturing ... biometric data of a second party" and lines 7 - 8, "... for identifying said second party using said captured biometric data ...").

3(d). In paragraph 22 of Appellant's Appeal Brief, Appellant discusses two "distinct" parties. While Appellant admits that his claim language does not explicitly use the term "distinct",

Appellant respectfully submits that it is implicit in the claim language that the first party is distinct from the second party; otherwise, the qualifiers “first” and “second” have no meaning.

Notwithstanding this argument, Appellant has no objection to inserting “wherein the first party is distinct from the second party” into his claim language (for example, at the end of Claim 1, line 8) if the Examiner disagrees that this is *already implicit* in the claim language.

3(e). Appellant’s discussion in paragraphs 19 - 23 of Appellant’s Appeal Brief (and in particular, in paragraph 22) is directed toward explaining that Crane (U. S. Patent 6,510,236) teaches authenticating the person who is the user of a device (and it is this *same* user who physically possesses the device in Crane) -- while, by contrast, Appellant’s claimed invention is not for that purpose. Rather, Appellant’s claimed invention is for identifying the second party, and nothing is said in Appellant’s claim language about attempting to identify the first party (i.e., the party who [physically] possesses the mobile pervasive device) because identifying the first party is not a feature of Appellant’s claimed invention.

3(f). Appellant also notes the Examiner’s discussion, in the Examiner’s Answer, of various synonyms of the word “possess”. See, for example, Page 7, lines 14 - 16 of the Examiner’s Answer, where it is stated that possess can mean “to own or have ownership of, or to have as property, it may even mean to have, hold or seize”. Appellant apologizes for confusion that may have resulted from this term, and notes that he uses the term “possess” in his claim language to mean “to hold”, i.e., to physically possess. Appellant believes this interpretation is implicit in his claim language, but has no objection to inserting “physically” as a qualifier of “possess” (for

example, in Claim 1, line 5, changing “possessed” to “physically possessed”) if the Examiner disagrees that this is *already implicit* in the claim language.

3(g). Accordingly, Appellants believes that the above discussion sufficiently clarifies any misunderstandings related to the “multiple parties” or “simultaneous involvement” discussions in Appellant’s Appeal Brief, and that this discussion further clarifies how Appellant’s claimed invention differs from the scenario of Crane’s invention.

3(h). If the Examiner believes that the distinction between Appellant’s first and second parties is still not sufficiently clear, Appellant has no objection to inserting “to said first party” into the claim language of the independent claims to further underscore this distinction -- for example, by changing “for identifying said second party using said captured biometric data” to “for identifying said second party to said first party using said captured biometric data”. (And as discussed earlier, the “captured biometric data” is that of the second party; see Claim 1, lines 4 - 6, “... capturing ... biometric data of a second party”).

4. Appellant notes that on Page 8, lines 15 - 16 of the Examiner’s Answer, the Examiner states that “appellant’s own drawing (figs. 1 and 2) show that appellant’s system is nothing more than the prior art” (emphasis original). Appellant respectfully disagrees, and notes that the Examiner has omitted reference to Appellant’s Fig. 3, which Appellant respectfully submits is clearly distinct from the prior art.

5. With regard to Appellant's independent Claim 10, the Examiner's Answer states that "the use of a device can not serve to distinguish a system, apparatus or product, if there is no structural differences" (Examiner's Answer, Page 11, lines 1 - 4). The holding in *RCA Corp. v. Applied Digital Data Systems, Inc.*, 221 USPQ 385, 389 n.5 (Fed. Cir. 1984) states

The limitations which must be met by an anticipatory reference are those set forth in each statement of function. . . . Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. (emphasis added)

Appellant respectfully submits that the "identifying" limitation on lines 7 - 8 of Claim 10 performs a different function than the authenticating taught by Crane. In particular, Appellant's "identifying" limitation is for identifying "said second party" who biometric data has been captured -- and as discussed above, this second party is not the device-possessing first party that is being authenticated by Crane. Accordingly, Appellant's "identifying" limitation performs a different function than what is taught by Crane, and in view of *RCA Corp.*, the limitations on lines 7 - 8 of Appellant's Claim 10 therefore cannot be met by Crane.

6(a). With reference to Appellant's Claims 3 and 12 and discussion thereof in paragraphs 31 - 35 of Appellant's Appeal Brief, Appellant respectfully notes that the discussion in the Examiner's Answer has misinterpreted the "photograph" specified in these claims. The Examiner's Answer spends considerable time (see, generally, Examiner's Answer, Pages 14 - 23) discussing use of photographs "as biometric data" (see, for example, Examiner's Answer, Page 14, lines 17 - 18; Page 18, line 14; and so forth). The Examiner's Answer further discusses use of a photograph, as biometric data, being used to authenticate a person by making algorithmic transformations and

comparisons (Examiner's Answer, Page 15, lines 4 - 17). Appellant's claim language does not specify use of photographs as biometric data, and Appellant's specification does not state that this is a feature of Appellant's invention. Rather, Appellant's specification and claims are intended to refer to conventional photographs, used simply as a picture of a person and not for authenticating the person through algorithmic transformations and comparisons.

6(b). In particular, Appellant respectfully notes that Claim 2 (from which Claim 3 depends) specifies "... transmitting said captured biometric data from said mobile device to a remote server" (Claim 2, lines 2 - 3), and then, in separate claim elements, "... retrieving, by said remote server [to which the biometric data has already been transmitted], information from a repository ..." (Claim 2, lines 4 - 5) and "... returning said retrieved information to said mobile pervasive device" (Claim 2, lines 6 - 7). It is in Claim 3 that this "retrieved information" is further qualified as "a photograph". In other words, after the remote server has already received the biometric information of the second party, that server then retrieves [different] information, namely (in Claim 3) a photograph of the second party, using the biometric information, and returns this [different] information (e.g., the photograph) to the mobile pervasive device. Again, the claim language does not specify that the photograph is used as the biometric data, and in fact, this interpretation is clearly inconsistent with the claim language, because the biometric data has already been sent to the remote server before the server retrieves the photograph.

6(c). Appellant's use of a photograph -- and more generally, the "retrieved information" specified in Claim 2, lines 4 - 5 -- is described in Appellant's specification on Page 13, lines 14 -

18. As stated therein, the “retrieved information” might comprise a picture of the person, a textual description of when the picture was taken, selected physical characteristics of the pictured person (such as the person’s height), etc. Again, to clarify, these described types of “retrieved information” are not intended as biometric data, and Appellant notes that the claim language of Claim 3 specifies “a photograph of a party to whom said biometric data corresponds” (emphasis added). That is, the biometric data “corresponds to” a party, and the photograph is a photograph of this party.

6(d). On Page 16, lines 3 - 4 of the Examiner’s Answer, the Examiner refers to “the use of photographs for biometric data collection”. As explained above, this is not what is specified in Appellant’s claim language. Page 17, line 1 - Page 18, line 15 *et seq.* of the Examiner’s Answer discuss Crane’s teachings of using various types of biometric “devices and schemes”, which could include photographs. This point is deemed moot because, as Appellant has explained, Appellant’s reference to “a photograph” is not for use of the photograph as biometric data.

6(e). Page 20, lines 1 - 19 of the Examiner’s Answer discusses the Fishbine reference (U. S. Patent 5,222,152) and its references to photographs or “mug shots”. Appellant respectfully submits that Fishbine’s references to photographs are distinct from Appellant’s claim language. Fishbine is referring to photographs being captured (i.e., taken) by the device that also captures the biometric data. See, for example, Abstract, last sentence (“The [portable fingerprint scanning] apparatus can also include a video camera to capture a photographic image ...”); col. 2, lines 34 - 36 (“... using a video camera to capture a photographic image ...”); col. 3, lines 22 - 27; and col.

4, line 52 - col. 5, line 9. By contrast, Appellant's claim language specifies that the photograph is returned to the mobile pervasive device (see Claim 2, lines 6 - 7), and thus it is clear that this is distinct from Fishbine's capturing of a photograph using the portable fingerprint scanning apparatus that also captures Fishbine's fingerprint data. (As a further clarification, the photographs are traveling in opposite directions in Appellant's claim language and in Fishbine. In Fishbine, the photograph is transmitted from the fingerprint scanning apparatus, as described at col. 3, lines 24 - 27, whereas in Appellant's claim language, the photograph is returned to the mobile pervasive device.)

6(f). Page 22, lines 3 - 4 of the Examiner's Answer state that processing a template (referring to a photograph used as biometric data) has not been claimed by Appellant. Appellant agrees. As has been demonstrated herein, Appellant does not claim this processing of a photograph "as biometric data" because it is not part of his claimed invention. Appellant also respectfully disagrees with the assertion on Page 22, line 22 - Page 23, line 2 that Appellant "has recited in his disclosure that the use of photographs as a biometric was well known". Rather, the discussion on Page 4, lines 11 - 12 and Page 4, line 18 of Appellant's specification (or on Page 5, line 5 thereof) of Fishbine's references to "capturing a photographic image" do not state that Fishbine was using this image for biometric data. Instead, Fishbine simply describes capturing a photograph or videotape of a person and then sending that from the fingerprint scanning apparatus to another device.

7(a). Claims 8, 17, and 26 are discussed in the Examiner's Answer on Page 24, line 21 - Page

27, line 14. This discussion states that “The operation of the device is not affected by the fact that it is being utilized to authenticate and verify repeatedly ...” (Page 25, lines 8 - 9). Page 25, lines 18 - 21 states “... access to the meeting site is only secured if someone keeps track of all the people entering and leaving who has been authenticated”. In fact, this is the purpose of the device-possessing first party in Appellant’s claims: the first party is using the [physically possessed] mobile pervasive device to identify other people, which can be construed as the first party “keeping track of all the people [i.e., the second parties] ... who [have] been authenticated”. See also Page 16, lines 13 - 14 of Appellant’s specification, stating “Upon traveling to an arbitrary meeting location, the pervasive device can be used by its [physical] possessor to reliably screen [i.e., to identify] each meeting attendee” (emphasis added).

7(b). In discussing these same Claims 8, 17, and 26, the Examiner’s Answer states (Page 26, line 20 - Page 27, line 10) that Crane in view of Maes (U. S. Patent 6,016,476) “clearly recites that biometric pervasive devices could be used for access control to a building” (Page 27, lines 1 - 5) and that using a pervasive biometric device for “identifying the users for gaining access” is clearly within the scope of these references (Page 27, lines 9 - 10). Appellant respectfully disagrees. While the prior art may disclose *certain types* of controlling access to a physical site using biometric devices placed at the physical site (described, for example, on Page 3, lines 9 - 11 and Page 3, lines 14 - 17 of Appellant’s specification), what Appellant has claimed is distinct from the prior art approach. To reiterate, Appellant claims that a mobile pervasive device [physically] possessed by a first party is used to identify a second party (or multiple second parties, namely “a plurality of meeting attendees”, when referring to Claims 8, 17, and 26). Thus, the first party

could physically move himself and his pervasive device from one meeting site to another, and can secure access to those different meeting sites (i.e., “enabl[ing] on-demand creation of a secure meeting site”; Claim 8, line 2) “at any location where the pervasive device possessor [and, by implication, the physically-possessed device] happens to be” (Page 16, lines 12 - 13 of Appellant’s specification).

8. In summary, Appellant’s claimed invention is not for authenticating a device possessor to the possessed device, as in the prior art, but is for identifying some other person (“the second party”) who is distinct from the physical possessor of the device (“the first party”).

9. Appellant therefore reasserts his arguments as presented in Appellant’s Appeal Brief, and maintains his position that the references fail to make out a *prima facie* case of anticipation under 35 U. S. C. §102 and obviousness under 35 U. S. C. §103.

CONCLUSION

In view of the above, Appellant respectfully submits that the rejection of appealed Claims 1 - 27 is overcome. Accordingly, it is respectfully urged that the rejection of appealed Claims 1 - 27 not be sustained.

Respectfully submitted,

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